

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomas Tuschl et al.
Serial No.: 09/821,832
Confirmation No.: 6240
Filed: March 30, 2001
For: RNA SEQUENCE-SPECIFIC MEDIATORS OF RNA
INTERFERENCE
Examiner: Christopher S. F. Low
Art Unit: 1635

Certificate of Electronic Filing Under 37 CFR 1.8

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: October 28, 2010

Electronic Signature for: / Sharon R. Lloyd /

Petition to Withdraw as Agent or Attorney of Record Under 37 C.F.R. § 1.36(B)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.36(b), Wolf Greenfield & Sacks, P.C. (“Wolf Greenfield”) (all of the practitioners of record associated with Customer number 23628) respectfully requests leave to withdraw as Agent or Attorney of Record in connection with the above referenced patent application, as well as the various continuations and divisionals thereof (the “Tuschl I Applications”), including abandoned and pending applications.

We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioners intend to withdraw from employment.

We have delivered to the client all papers and property (including funds) to which the client is entitled.

We have notified the client of any responses that may be due and the time frame within which the client must respond.

By Memorandum and Order dated September 14, 2010 (the “Order”), the United States District Court for the District of Massachusetts, (Civil Action No. 09-11168), found that as a result of conflicting instructions from the co-assignees of the Tuschl I Applications, the appropriate course of action would be for Wolf Greenfield to withdraw from the Tuschl I patent prosecution. Withdrawal at this time is appropriate because the Tuschl I Applications do not have an Office action due for which there remains insufficient time for the Applicants to file a reply.

In further support of this Petition, Wolf Greenfield states as follows:

Background

The first Tuschl I provisional application was filed with the USPTO on March 30, 2000. The application was later assigned to Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften, E.V. (“Max-Planck”), the Whitehead Institute for Biomedical Research (“Whitehead”), the Massachusetts Institute of Technology (“MIT”) and the University of Massachusetts (“UMass”) (the “Co-Assignees”). By contract, the Co-Assignees delegated the right to manage the prosecution of the Tuschl I Applications to Whitehead.

Initially, the prosecution of the Tuschl I Applications was conducted by the law firm of Hamilton, Brook, Smith & Reynolds, P.C. In the Spring of 2004, after disagreements among the Co-Assignees had arisen, Whitehead engaged Wolf Greenfield to continue the prosecution of the Applications. At Whitehead’s request, the Co-Assignees executed Revocations of Powers of Attorney and Appointments of New Attorneys and/or Agents in favor of Wolf Greenfield. Thereafter, Wolf Greenfield prosecuted the Tuschl I Applications in accordance with the instructions of Whitehead. Disputes, however, continued among the Co-Assignees concerning the inclusion of certain priority claims and data in the Tuschl I Applications.

The Litigation

On June 26, 2009, Max-Planck filed a lawsuit against UMass, MIT and Whitehead in which it claimed, among other things, that the parties had wrongfully misappropriated Max-Planck's technologies and had breached fiduciary duties arising out of the parties' contractual arrangements. That same day, Max-Planck filed a separate lawsuit against Wolf Greenfield alleging, *inter alia*, that it had an attorney-client relationship with Wolf Greenfield and further seeking a declaration that Wolf Greenfield be required to cease its prosecution of the Tuschl I Applications (the "Malpractice Litigation").

On July 20, 2009, Max-Planck petitioned the USPTO to revoke its Appointment of Wolf Greenfield and to allow Rothwell, Figg, Ernst & Manbeck, P.C. to appear on its behalf and to act for less than all of the applicants (the "Goldstein Petition"). The USPTO granted Max-Planck's Goldstein Petition on September 3, 2009 on the basis of the "divergent interests" of Max-Planck and the other co-owners. The practical result is that Wolf Greenfield may not prosecute the Tuschl I patent applications in any manner without Max-Planck's express consent because the USPTO will not act upon filings from less than all of the co-owners. In re Goldstein, 16 USPQ 1963, 1964 (Comm'r Pat. 1988); 37 C.F. R., §1.33(a) and (b)(4).

In the Malpractice Litigation, Wolf Greenfield sought summary judgment on all claims asserted by Max-Planck. Max-Planck sought summary judgment on the issue of whether an attorney-client relationship existed between it and Wolf Greenfield. As detailed in the Order, a copy of which is attached as Exhibit A, the Court ruled that most of Max Planck's claims were barred by the applicable statute of limitations. The Court also found, however, that Wolf Greenfield had an implied attorney-client relationship with Max-Planck (as well as an express attorney-client relationship with Whitehead). As a result, the Court further concluded that

[t]he appropriate course of action once Wolf Greenfield became aware of the conflicting instructions from its joint clients, Whitehead and Max-Planck, would have been to withdraw from the Tuschl I patent prosecution.

Relief Requested

Wolf Greenfield respectfully disagrees with the Court's ruling that it had an implied attorney-client relationship with Max-Planck and reserves the right to challenge the ruling on appeal. However, until that ruling is reversed, Wolf Greenfield has determined that it can no longer effectively represent Whitehead in connection with the Tuschl I Applications, nor can it file documents or take any action in the USPTO under the powers of attorney provided by Whitehead, UMass and MIT. Wolf Greenfield notified Whitehead of its position on September 21, 2010, and UMass and MIT on September 22 and 23, 2010. By letter dated September 24, 2010, Wolf Greenfield also notified Max-Planck that it intended to withdraw.

Accordingly, Wolf Greenfield respectfully requests that the USPTO grant it leave to withdraw as Agent or Attorney in connection with the Tuschl I Applications. Wolf Greenfield has taken reasonably practicable steps to protect the Co-Assignees from undue prejudice, including the filing of an appeal brief on October 2, 2010 in connection with the Tuschl I Applications with the consent of all Co-Assignees. Withdrawal is appropriate at this time because the Tuschl I Applications do not have an Office action due for which there remains insufficient time for the Applicants to file a reply.

Change the correspondence address and direct all future correspondence to Assignee:

**Whitehead Institute for Biomedical Research
9 Cambridge Center, Room 111
Cambridge, MA 02142
617.258.5000**

I am authorized to sign on behalf of myself and all withdrawing practitioners.

Dated: October 28, 2010

/Helen C. Lockhart/

Helen Lockhart

Registration No. 39,248

Counsel for Whitehead Institute for Biomedical
Research;

Holder of Power of Attorney for University of
Massachusetts and Massachusetts Institute of
Technology

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